



UNITED STATES PATENT AND TRADEMARK OFFICE

54
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,060	06/13/2000	Tatsuya Eguchi	52178-020	5731
20277	7590	06/27/2005	EXAMINER	
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			HAN, QI	
			ART UNIT	PAPER NUMBER
			2654	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/593,060	EGUCHI ET AL.
	Examiner Qi Han	Art Unit 2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 November 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/03/2004 has been entered.

Response to Amendment

2. The Applicant(s) amended claims 1, 10 and 14 (see amendment: pages 2-7), and filed the RCE examination request, on 11/03/2004.

Response to Arguments

3. Applicant's arguments with respect to claim rejection under 35 USC 112 2nd and 103 (amendment: pages 9-13) have been considered, the response to the arguments is directed to the new claim rejection in this office action (see detail below).

Specification

4. The title of the invention is objected because the disclosed application does not contribute any new mechanism or functionality of translation itself, but using well known textural language

translation features for applications on a copy machine. A new title is required that is clearly indicative of the invention to which the application is directed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 6 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitation “each language group including the translated document data translated into a common language that is different from the common language that the translated document data is translated into in each other language group” is vague and/or not descriptive. The examiner cannot figure out what the applicant is trying to say and which embodiments in Figs. 2-5 can be associated with, therefore the limitation is treated as being indefinite.

Regarding claim 6, the limitation “the document data” lacks clearly defined scope for the claim. Since the limitation can be interpreted in many different ways, such as separate documents (files), single document, pages, paragraphs, sentences, phrases, words (tokens), content table, database text records, etc., its different interpretations may direct the claim to structurally incompatible embodiments and/or cause an enablement problem (see below), the limitation is treated as being indefinite.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for text (or textual) document data, does not reasonably provide enablement for “document data”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Regarding claim 1-18, the limitation “document data” includes text, video, audio and speech data, which has much broader scope than only text (or textual) document data that the application is processed for translation. In terms of translation for other type of data, such as speech or audio, there is no disclosure in the specification, therefore, the specification does not enable any person skilled in the art to make and/or use the invention commensurate in scope with these claims.

7. Further, claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 6, the limitation “to translate the document data including a plurality of different languages into at least one language...” lacks detail discretion in the specification to support the claimed invention. It is noted that the closet disclosure (see specification: page 19,

lines 2-13 and Fig. 16) does not specifically describe what kind of document data (source data) is (such as sentences, paragraphs, pages, or separate documents, in mixed languages) and how to access and/or process the document data (such as how to identify different language if they are mixed in a text; whether the process is page-by-page, file-by-file, in parallel, or in automatic or manual page (file) selection). Therefore, the claim subject matter was not described in such a way as to enable one skilled in the art to make and/or use the claimed invention, without undue experimentations. As best understood, the limitation will be interpreted as “to translate the document data, in manual page selection, including a plurality of different languages into at least one language...” hereinafter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2, 4-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al. (5,701,497) hereinafter referenced as Yamauchi, in view of Flores et al. (6,370,498 B1) hereinafter referenced as Flores.

As per claim 1, as best understood in view of claim rejection under 35 USC 112 1st and 2nd (see above), Yamauchi teaches a translating apparatus comprising:

“translating means for translating document data into another language” (Fig.1 and col. 7, lines 41-54, ‘translation unit 9’);

“an output means for outputting the translated document data translated by said translating means” (col. 4, line 36 to col. 5, line 11 and Fig. 1, ‘bitmap exp 10’ and ‘plotter’);

“a mode setting unit for setting the translating apparatus in a first mode or a second mode” (col. 4, lines 36-60, ‘wherein one of said first and second output means is selectively activated (mode setting)’);

“a controller”, (col.,7, lines 55-56, ‘the system of Fig. 1 includes a system controller’, which necessarily controls each unit, such as ‘OCR’, ‘translation’ and ‘outputs text data representing the result of translation’);

“wherein, in a case where the first (or second) mode is set, said controller controls said translating means so as to translate the document data into” a target language “different from an original language of the document data” and “controls said output unit so as to output the translated data translated into” the target language, (col. 4, lines 39-45, ‘translating a received document, written in a first language, to a second, different language...output...in said second language... wherein one of said first and second output means is selectively activated (setting mode)’; col.,7, line 48, ‘outputs text data representing the result of translation’);

“wherein, in a case where the second mode is set, said controller controls said translating means so as to translate the document data into” a target language “different from an original language of the document data” and “controls said output unit so as to output the translated data translated by groups” “including the translated language document data translated in” the target language, (col. 4, lines 39-45, ‘translating a received document, written in a first language, to a

second, different language...output means for outputting...simultaneously (another mode) in said first language and said second language'; Fig. 24, shows the output of the document in the original and target languages by respective paragraphs and their orders (interpreted as by group)).

But, Yamauchi does not explicitly teach translating the received document into a **plurality of languages** and outputting them by certain group. However, this feature is well known in the art as evidenced by Flores who discloses apparatus and methods for multilingual user access (title), comprising that 'the database stores translation of documents in multiple languages and a variety of format' and 'user can choose to have the multiple translations' and 'to have a work displayed in a written text in two or more separate languages' (Figs. 3-4, col. 3, line 64 to col. 4, line 8 and col. 5, lines 27-57), which suggests the system has capability of outputting multiple languages in different groups. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yamauchi by providing a sorter and related sorting functionality, as taught by Flores, for the purpose of being beneficial to users presenting and displaying a written text and its multiple translations in two or more separate languages (Flores: col. 4, lines 5-8).

As per claim 2, Yamauchi further teaches "said output unit includes a printing device for printing the translated document in a sheet" (Fig. 1, 'plotter 11').

As per claim 4, Yamauchi in view of Flores teaches "said output unit includes a display for displaying the translated document data" (Yamauchi: Figs. 2 and col. 8, lines 33-34, 'display unit 33').

As per claim 5, Yamauchi in view of Flores teaches “an operation unit for specifying an original language and a plurality languages to be translated” (Yamauchi: Figs. 2 col. 7, lines 62, ‘system controller’, ‘input device 32.. used by an operator’; Flore: Figs 2-4, which necessary includes specifying the related languages for the translation).

Claims 6-18 are the same in scope and content as claims 1-2 and 4-5 above and therefore are rejected under the same rationale.

9. Claims 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi in view of Flores, and further in view of Miyahara et al. (6,314,213 B1) hereinafter referenced as Miyahara.

As per claim 3, Yamauchi in view of Flores does not explicitly teach “said output includes a sorter for sorting printed sheets by the group”. However, this feature is well known in the art as evidenced by Miyahara who teaches using ‘a sorter 22’ for discharging ‘paper sheet’ (Fig.2) (col. 7, lines 28-29) and ‘a soft key which is used to sort, staple/sort’) (col. 8, line 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Yamauchi in view of Flores with Miyahara by providing a sorter and related sorting functionality, as taught by Miyahara, for the purpose of implementing user preferred function, like sorting the resultant sheets, (Miyahara: col. 8, lines 4-13).

Conclusion

10. Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Mail Stop _____
Commissioner for Patents

P.O. Box 1450
Alexandria, VA 22313-1450

or faxed to: 571-273-8300, (for formal communications intended for entry)
Or: 571-273-8300, (for informal or draft communications, and please label
"PROPOSED" or "DRAFT")

If no Mail Stop is indicated below, the line beginning Mail Stop should be omitted from the address.

Effective January 14, 2005, except correspondence for Maintenance Fee payments, Deposit Account Replenishments (see 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(c)), please address correspondence to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

U.S. Patent and Trademark Office
Customer Window, Mail Stop _____
Randolph Building
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qi Han whose telephone numbers is (571) 272-7604. The examiner can normally be reached on Monday through Thursday from 9:00 a.m. to 7:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (571) 272-7602.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: ebc@uspto.gov. For general information about the PAIR system, see <http://pair-direct.uspto.gov>.

QH/qh
June 19, 2005



DAVID D. KNEPPER
PRIMARY EXAMINER